UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 February 2002</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This office action is responsive to communication filed on 02/28/2002.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

2. **Claims 1-3, 7-12, and 16-20** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cabrera et al (Cabrera), U.S. Patent No. 6,269,382 B1 in view

of Hull et al (Hull), U.S. Patent No. 6,704,118 B1.

Regarding **claim 1**, Cabrera teaches the invention substantially as

claimed. Cabrera discloses a method comprising:

operatively coupling a removable data storage media to a digital sender

device (*fig. 1, items 20, 29-30; column 8, lines 38-67*);

causing said digital sender device to:

optically scan at least one object to form corresponding scanned

object data (*column 24, lines 46-67; column 25, lines 1-31*),

generate an outgoing message data including said scanned object data

output said message data (*column 10, lines 1-56; column 24, lines 46-67;*

column 25, lines 1-30), and

store said message data on said removable data storage device (*column 8, lines 38-67; column 34, lines 39-47*).

However, Cabrera does not specifically disclose providing recipient data address, and generate an outgoing message (including scanned object) data using said recipient address.

In the same field of endeavor, Hull teaches a method in which ("...*data representing a network address of the source or recipient device can be stored along with the archived image. An IP address can be stored with documents originating from a workstation assigned to that particular IP address...*) [*see Hull, column 10, lines 3-17*].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Hull's teachings of a method and apparatus to provide recipient address data with scanned object data, with the teachings of Cabrera, for the purpose of "*providing a system and a method for remote storage that allows local storage to be rapidly freed should the need arise to rapidly reclaim local storage, and to provide a hierarchical storage system that maximizes the amount of local storage that can be transferred to a remote storage...*" as stated by Cabrera in lines 28-41 of column 6. By this rationale **claim 1** is rejected.

Regarding **claim 2**, the combination Cabrera-Hull teaches the method of claim 1, wherein the method as recited in claim 1, wherein operatively coupling said removable data storage media to said digital sender device further includes:

positioning a writable optical disc in a writable optical disc drive within said digital

sender device. [*see Cabrera, column 8, lines 38-67; column 9, lines 1-37*]. The

same motivation that was utilized in the combination of claim 1, applies equally

as well to claim 2 [*see Cabrera, column 6, lines* 28-41]. By this rationale **claim 2**

is rejected.

Regarding **claim 3**, the combination Cabrera-Hull teaches the method as

recited in claim 1, wherein said scanned object data further includes a plurality of

different versions of said scanned object data [*see Hull, column 10, lines 58-67;*

column 11, lines 1-26]. The same motivation that was utilized in the combination

of claim 1, applies equally as well to claim 3 [*see Cabrera, column 6, lines* 28-

41]. By this rationale **claim 3** is rejected.

Regarding **claim 7**, the combination Cabrera-Hull teaches the method as

recited in claim 3, wherein said plurality of different versions of said scanned

object data includes a first version and a second version, said second version

being a data compressed version of said first version [*see Hull, column 7, lines*

41-67; column 8, lines 1-26]. The same motivation that was utilized in the

combination of claim 1, applies equally as well to claim 7 [*see Cabrera, column 6,*

lines 28-41]. By this rationale **claim 7** is rejected.

Regarding **claim 8**, the combination Cabrera-Hull teaches the method as

recited in claim 7, wherein causing said digital sender device to output said

message data further includes: causing said digital sender device to output said

second version within said message data [*see Hull, column 10, lines 40-67;*

column 11, lines 1-26]. The same motivation that was utilized in the combination

of claim 1, applies equally as well to claim 8 [*see Cabrera, column 6, lines 28-*

41]. By this rationale **claim 8** is rejected.

Regarding **claim 9**, the combination Cabrera-Hull teaches the method as

recited in claim 7, wherein causing said digital sender device to store said

message data on said removable data storage device further includes: causing

said digital sender device to store said first version on said removable data

storage device [*see Hull, column 10, lines 40-67; column 11, lines 1-26*]. The

same motivation that was utilized in the combination of claim 1, applies equally

as well to claim 9 [*see Cabrera, column 6, lines 28-41*]. By this rationale **claim 9**

is rejected.

Regarding **claim 10**, the combination Cabrera-Hull teaches the method as

recited in claim 4, wherein said message data includes data selected from a

group of data comprising scanned object data, recipient address data, timestamp

data, authentication related data, device identifying data, control data, text data,

graphics data, and image data [*see Cabrera, column 25, lines 1-67*]. The same

motivation that was utilized in the combination of claim 1, applies equally as well

to claim 10 [*see Cabrera, column 6, lines 28-41*]. By this rationale **claim 10** is

rejected.

Regarding **claim 11**, the combination Cabrera-Hull teaches an apparatus

comprising [*see Cabrera, fig. 1, items 20-54*]: a digital sender device having:

a data storage device configurable to access a removable data storage

media [*see Cabrera, column 8, lines 38-67*],

a scanning mechanism configurable to scan at least one object and

produce corresponding scanned object data [*see Cabrera, column 24, lines 46-*

67; column 25, lines 1-31],

a communication interface configurable to operatively connect to at least

one network [*see Cabrera, column 8, lines 38-67; column 9, lines 1-37*],

a user interface configurable to receive user inputs [see Cabrera, fig. 1,

item 40; *column 8, lines 38-67; column 9, lines 1-37*], and

logic operatively coupled to said data storage device, said scanning

mechanism, said communication interface, and said user interface, wherein said

logic is configured to combine recipient address data from said user interface

with at least a portion of said scanned object data to form message data that is

then output by said communication interface and stored by said data storage

device on said removable data storage device [*see Hull, column 10, lines 3-17*].

The same motivation that was utilized in the combination of claim 1, applies

equally as well to claim 11 [*see Cabrera, column 6, lines* 28-41]. By this rationale

claim 11 is rejected.

Regarding **claim 12**, the combination Cabrera-Hull teaches the apparatus

as recited in claim 11, wherein said scanned object data further includes a

plurality of different versions of said scanned object data [*see Hull, column 10,*

lines 58-67; column 11, lines 1-26]. The same motivation that was utilized in the

combination of claim 1, applies equally as well to claim 12 [*see Cabrera, column 6, lines* 28-41]. By this rationale **claim 12** is rejected.

Regarding **claim 16**, the combination Cabrera-Hull teaches the apparatus as recited in claim 12, wherein said plurality of different versions of said scanned object data includes a first version and a second version, said second version being a data compressed version of said first version [*see Hull, column 7, lines 41-67; column 8, lines 1-26*]. The same motivation that was utilized in the combination of claim 1, applies equally as well to claim 16 [*see Cabrera, column 6, lines* 28-41]. By this rationale **claim 16** is rejected.

Regarding **claim 17**, the combination Cabrera-Hull teaches the apparatus as recited in claim 16, wherein said logic is configured to include said second version within said message data that is output by said communication interface [*see Hull, column 10, lines 40-67; column 11, lines 1-26*]. The same motivation that was utilized in the combination of claim 1, applies equally as well to claim 17 [*see Cabrera, column 6, lines* 28-41]. By this rationale **claim 17** is rejected.

Regarding **claim 18**, the combination Cabrera-Hull teaches the apparatus as recited in claim 16, wherein said logic is configured to include said first version within said message data that is stored by said data storage device [*see Hull, column 10, lines 40-67; column 11, lines 1-26*]. The same motivation that was utilized in the combination of claim 1, applies equally as well to claim 18 [*see Cabrera, column 6, lines* 28-41]. By this rationale **claim 18** is rejected.

Regarding **claim 19**, the combination Cabrera-Hull teaches the apparatus as recited in claim 11, wherein said message data includes data selected from a group of data comprising scanned object data, recipient address data, timestamp data, authentication related data, device identifying data, control data, text data, graphics data, and image data [*see Cabrera, column 25, lines 1-67*]. The same motivation that was utilized in the combination of claim 1, applies equally as well to claim 19 [*see Cabrera, column 6, lines* 28-41]. By this rationale **claim 19** is rejected.

Regarding **claim 20**, the combination Cabrera-Hull teaches the apparatus as recited in claim 11, further comprising: a multiple function device that includes:

said digital sender device, and a printer mechanism operatively coupled to said logic within said digital sender device, and wherein said logic is further configured to cause said printing mechanism to print out at least a portion of said message data [*see Hull, fig. 1, item 112; fig. 5, item 512; column 2, lines 21-32; column 3, lines 1-67; column 4, lines 1-60*]. The same motivation that was utilized in the combination of claim 1, applies equally as well to claim 20 [*see Cabrera, column 6, lines* 28-41]. By this rationale **claim 20** is rejected.

3. **Claims 4-6,** and **13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cabrera, and Hull as applied to claims 1-3, 7-12, 16-20, further in view of Parulski et al (Parulski) U.S. Patent No. 5,440,401 B1.

Regarding **claim 4**, the combination Cabrera-Hull teaches the invention substantially as claimed. Cabrera-Hull discloses the method as recited in claim 3, wherein said scanned object includes a plurality of different versions of said scanned object data. However, Cabrera-Hull fails to disclose a said plurality of different versions of said scanned object data that includes a first resolution version and a second resolution version, said second resolution version having a lower level of resolution than said first resolution version.

In the same field ion endeavor, Parulski teaches a method for image data processing whereas, "in the same database storage contains high resolution images, an a low resolution index data file of the same images where images can be retrieved and displayed.." [*see Parulski, column 6, lines 50-67*].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Hull's teachings of a method and apparatus to provide recipient address data with scanned object data, with the teachings of Cabrera, for the purpose of "*providing a system and a method for remote storage that allows local storage to be rapidly freed should the need arise to rapidly reclaim local storage, and to provide a hierarchical storage system that maximizes the amount of local storage that can be transferred to a remote storage...*" as stated by Cabrera in lines 28-41 of column 6. Parulski further provides motivation to combine by stating that "*the accompanying of the low and high resolution will allow the user to readily call up and display the high resolution image associated with a selected low resolution*

image..."[see Parulski, column 2, lines 18-23]. By this rationale **claim 4** is

rejected.

Regarding **claim 5**, the combination Cabrera-Hull- Parulski teaches the

method as recited in claim 4, wherein causing said digital sender device to output

said message data further includes: [*see Parulski, column 6, lines 6-67*]. The

same motivation that was utilized in the combination of claim 4, applies equally

as well to claim 5 [*see Parulski, column 2, lines 18-23*]. By this rationale **claim 5**

is rejected.

Regarding **claim 6**, the combination Cabrera-Hull- Parulski teaches the

method as recited in claim 4, wherein causing said digital sender device to store

said message data on said removable data storage device further includes:

causing said digital sender device to store said first resolution version on said

removable data storage device: [*see Parulski, column 6, lines 6-67*]. The same

motivation that was utilized in the combination of claim 4, applies equally as well

to claim 6 [*see Parulski, column 2, lines 18-23*]. By this rationale **claim 6** is

rejected.

Regarding **claim 13**, the combination Cabrera-Hull- Parulski teaches the

apparatus as recited in claim 12, wherein said plurality of different versions of

said scanned object data includes a first resolution version and a second

resolution version, said second resolution version having a lower level of

resolution than said first resolution version [*see Parulski, column 6, lines 50-67*].

The same motivation that was utilized in the combination of claim 4, applies

equally as well to claim 13 [*see Parulski, column 2, lines 18-23*]. By this rationale **claim 13** is rejected.

Regarding **claim 14**, the combination Cabrera-Hull- Parulski teaches the apparatus as recited in claim 13, wherein said logic is configured to include said second resolution version within said message data that is output by said communication interface [*see Parulski, column 6, lines 6-67*]. The same motivation that was utilized in the combination of claim 4, applies equally as well to claim 14 [*see Parulski, column 2, lines 18-23*]. By this rationale **claim 14** is rejected.

Regarding **claim 15**, the combination Cabrera-Hull- Parulski teaches the apparatus as recited in claim 13, wherein said logic is configured to include said first resolution version within said message data that is stored by said data storage device: [*see Parulski, column 6, lines 6-67*]. The same motivation that was utilized in the combination of claim 4, applies equally as well to claim 15 [*see Parulski, column 2, lines 18-23*]. By this rationale **claim 15** is rejected.

Conclusion

4. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

March 23, 2005